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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,360	10/29/2001	Peter M. Bonutti	BON-4250-1	3765
33771	7590	01/21/2004	EXAMINER	
PAUL D. BIANCO: FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI, & BIANCO P.L. 601 BRICKELL KEY DRIVE, SUITE 404 MIAMI, FL 33131			ROBERT, EDUARDO C	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 01/21/2004  
8

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/007,360	BONUTTI, PETER M.	
Examiner	Art Unit		
Eduardo C. Robert	3732		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 30 October 2003.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) See Continuation Sheet is/are pending in the application.  
4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1,5-9,11,12,16,26,27,29,46-51,62-68,74-78,120-124,126,128-135 and 138 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 29 October 2001 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.  
13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.  
14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6)  Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1,5-9,11,12,16,22,26-29,46-51,62-69,74-84,86,87,101-110,112,113,116-135 and 138.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 22,28,29,69,79-84,86,87,101-110,112,113,116-119,125 and 127.

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of Species VI (Figures 9 and 10) in Paper No. 5 is acknowledged. **Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse** (MPEP § 818.03(a)).

It is acknowledged that applicant believes claims 1, 5-9, 11, 12, 16, 26, 27, 29, 46-51, 62-68, 74-78, 120-124, 126, 128-135, and 138 read on the elected Species. The examiner agrees with applicant, however, claim 29 does not read on the elected species because it depend from a claim that applicant believes does not read on the Species elected, i.e. claim 28, thus claim 29 does not read on the elected Species. It is acknowledged that applicant believes claims 1, 26, 62, 120, 129, 46, and 74 are generic claims. It is noted that claims 1, 26, 62, 120, 129, 46, and 74 are not considered generic claims because they do not read on all the different Species presented.

Claims 22, 28, 29, 69, 79-84, 86, 87, 101-110, 112, 113, 116-119, 125, and 127 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election has been treated as an election **without** traverse.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-9, 11, 12, 16, 26, 27, 29, 46-51, 62-68, 74-78, 120-124, 126, 128-135, and 138 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neufeld (U.S. Patent 3,842,824).

Neufeld discloses a method comprising the step of positioning a retainer member, e.g. pin 10, in a portion of a bone in the patient's body, and connecting the retainer member with tissue that is to be secured. The step of positioning the member includes utilizing the member to form an opening in the portion of the bone. The portion of the bone is a first bone and the tissue to be secured is a second bone (see Figure 1). Neufeld discloses the claimed invention except for the member being made from bone. It would have been obvious to one having ordinary skill in the art at the time the invention was made to practice the method of Neufeld with a member being made of bone, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

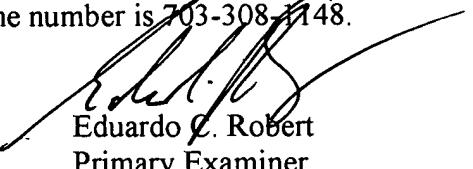
### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-4148.

  
Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C.R.